

REMARKS

Claims 1-8, 10-15, 17, and 19-29 are pending in this application. Reconsideration of the rejections in view of the following remarks is respectfully requested.

Rejection under 35 USC §102(e)

Claims 5, 6, 8-13, 15-17 and 19-28 stand rejected under 35 USC §102(e). The Examiner alleged in the Office Action as follows:

The reply filed on September 19, 2002 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): **It is correct in stating that . . . the US filing date of the instant application were filed [sic] before the U.S. filing date fo Semb. However, the priority date of Semb was June 11, 1997 and Semb appears to be disclosed [sic] all of the limitations of the instant claim.”** (Emphasis added).

Applicant respectfully traverse the rejection.

Despite the Examiner's allegation, Semb (USP No. 6,133,981) is not prior art under 35 USC 102(e). The US filing date (April 7, 1998) of the present application are prior to the US filing date (June 5, 1998) of Semb. The MPEP 2136.03 specifically prohibits the use of foreign filing date in 102(e) rejection as follows:

2136.03 Critical Reference Date

I. FOREIGN PRIORITY DATE

Reference's Foreign Priority Date Under 35 U.S.C. 119(a)-(d) and (f) Cannot Be Used as the 35 U.S.C. 102(e) Reference Date

A U.S. patent reference is effective prior art as of its U.S. filing date. 35 U.S.C. 119(a)-(d) and (f) does not modify section **102(e) which is explicitly limited to certain references "filed in the United States before the invention thereof by the applicant"** (emphasis added). Therefore, **the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) and (f) cannot be used to antedate the application filing date**. In contrast, applicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference's U.S. filing date. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966) (Hilmer I) (Applicant filed an application with a right of priority to a German application. The examiner rejected the claims over a U.S. patent to Habicht based on its Swiss priority date. The U.S. filing date of Habicht was later than the application's German priority date. The court held that **the reference's Swiss priority date could not be relied on in a 35 U.S.C. 102(e) rejection**. Because the U.S. filing date of Habicht was later than the earliest effective filing date (German priority date) of the application, the rejection was reversed.). (Emphasis added).

Thus, it is current law under Hilmer Doctrine that the effective date of the application as a 35 U.S.C. 102(e) prior art is not the filing date in the foreign country (i.e., priority date) but the filing date in the United States. The only exception is that 35 U.S.C. 102(e) provides as follows:

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; . . ."

Even the statute is effective from Nov. 29, 2000, and applicable to applications filed after that date. The statute cannot be applied to the present application because the present application was filed on October 10, 2000, which is before the amended statute become effective. Moreover, the Semba application in Japan was filed in Japanese language under Japanese patent law, not under PCT, and Semba does not fall within “originally published in English under PCT.”

Therefore, there is no basis from any aspect that the present application can be rejected under 35 USC §102(e) over Semba, and the 35 USC §102(e) rejection has been improper and should be withdrawn. Also, Applicant naturally should not be required to submit an English translation of the foreign priority application.

It is submitted that all pending claims are in condition for allowance. Reconsideration of the rejections, withdrawal of the rejections and an early issue of a Notice of Allowance are earnestly solicited.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees which may be due with respect to this paper, may be charged to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, WESTERMAN & HATTORI, LLP



Sadao Kinashi
Attorney for Applicant
Reg. No. 48,075

SK/fs

Atty. Docket No. **980511B**
Suite 1000, 1725 K Street, N.W.
Washington, D.C. 20006
(202) 659-2930



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